| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/910,853 | 07/24/2001 | Susumu Kobayashi | 2001_1035A | 4034 |

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| EXAMINER |
|---|
| TANG, KAREN C |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2151 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 12/29/2006 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | Application No. | Applicant(s) |
|---|---|---|
| *Office Action Summary* | 09/910,853 | KOBAYASHI ET AL. |
| | Examiner | Art Unit |
| | Karen C. Tang | 2151 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 November 2006.*

2a)☐ This action is **FINAL.**　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20,24,28,32,36,39,43,47,50,54 and 58* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20, 24, 28, 32, 36, 39, 43, 47, 50, 54, and 58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

- Claims 1-20, 24, 28, 32, 36, 39, 43, 47, 48, 50, 54, and 58 are presented for further

  examination.

- 112 rejections of previous office action is withdrawn.


## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments, see argument/remark, page 25, filed 11/9/06, with respect to

Naick et al is not a valid prior art have been fully considered and are persuasive. The previous

office action filed on 8/9/06 has been withdrawn.


### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-20, 24, 28, 32, 36, 39, 43, 47, 48, 50, 54, and 58 are rejected under 35 U.S.C.

103(a) as being unpatentable over Applicant Admit Prior Art (AAPA : remarks/arguments

received on 10/07/05) in view of Hanna et al hereinafter Hanna (US 7,054,905) in further view

of Pollack (US 2002/0019851).


1. Referring to Claims 1, 5, 9, 13, 17, 20, 24, 28, 32, 36, 39, 43, 47, 50, 54, and 58, AAPA

discloses an e-mail transmission/reception system including a mail terminal, a mail server, and a

mail gateway, wherein said mail gateway is connected to the said mail terminal via a network

and to said mail server via another network (pages 26, Lines 13 - 26),

wherein said mail gateway comprises:

a list transmission unit operable to generate a list of identifiers (a list is an single element: a mail

ID is a list) generated by the said identifier generation (it is the system comprises a identifier

generation unit in able to create mail id) and transmit the identifier list to said mail terminal

(page 26, Lines 13-26);

a reception unit operable to receive attached-file specifying e-mail transmitted from said mail

terminal (email that comprising an attached file received from terminal, page 26, Lines 13-26),

the attached-file specifying e-mail including one or more identifiers generated by said identifier

generation unit (page 26, Lines 18-26);

an attached file acquisition unit operable to acquire attached files from the-said attached file

holding unit,  the at least one attached file corresponding to the at least one identifier included in

the attached-file specifying e-mail received by said reception unit (page 26, Lines 18-26);

a construction unit operable to construct a file attached e-mail by attaching the at least attached

files acquired by the-said attached file acquisition unit to the attached-file specifying e-mail

received by said reception unit (page 26, Lines 19-23);

and a mail transmission unit operable to transmit the file attached e-mail constructed by said

construction unit to said mail server (page 26, Lines 19-23); and

wherein said mail terminal comprises:

a list reception unit operable to receive the identifier list from said mail gateway (that the

terminal is able to received email with attachments, page 26, Lines 13-27);

a preparation unit operable to prepare the attached file specifying email including the at least one

identifier (when selected all the attachments, it is equivalent to the conventional ways) selected

by the user among the unique identifiers from the identifier list as a substitutes for at least one

attached file that the user wants to attach to the e-mail (page 26, Lines 13-27); and

a transmission unit operable to transmit the prepared attached-file specifying email to said mail

gateway (page 25, Lines 23-26).

Although AAPA disclosed the invention substantially as claimed, AAPA is silent in regard to

indicate server comprising an attached file holding unit operable to receive an e-mail addressed

to a user who possesses said mail terminal and hold one or more attached files included in the e-

mail;

and a mail distribution unit operable to receive a file attached e-mail transmitted from said mail

gateway and distribute the file attached e-mail to a respective address of one or more receivers of

the e-mail;

Hanna, in an analogous art, disclosed an attached file holding unit operable to receive an e-mail

addressed to a user who possesses said mail terminal and hold one or more attached files

included in the e- mail (refer to Col 1, Lines 50-55);

and a mail distribution unit operable to receive a file attached e-mail transmitted from said mail

gateway and distribute the file attached e-mail to a respective address of one or more receivers of

the e-mail (refer to Col 3, Lines 60-67, Col 4, Lines 1-15);

Hence, providing the feature disclosed by Hanna, would be desired for user to utilized it in the

gateway system in order for the system maintain the stabilities and avoid latency by taking off

loads from the server.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the

art to have modify the system of AAPA by including the features in Hanna.

The suggestion/motivation for doing so would have been that by eliminate the need for

individual decision and input by the user, stimulating the operating time and allow system to

eliminate unnecessary space being allocated.

Although AAPA and Hanna disclosed the invention substantially as claimed, AAPA is silent in

regard to comprising an identifier generation unit operable to generate an unique identifier for

each attached files held by said attached file holding unit, respectively;

Pollack, an analogous art disclosed an identifier generation unit (producing calls) operable to

generate an unique identifier for each attached files held by said attached file holding unit,

respectively (refer to 0013);

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to

combine AAPA, Hanna, and Pollack, because it would have been desirable to avoid significant

amount of effort to manually copy the file to the server and used up unnecessary system

resources.

The suggestion/motivation would have been that by managing the stored file, it allows user to

quickly and easily manage the files on a network storage system on any device.

Although AAPA and Hanna combined suggested the invention substantially as claimed, both

AAPA and Hanna are silent in regarding to disclosed the attached-file specifying e-mail

including at least one identifier among the unique identifiers generated by said identifier

generation unit for each of the plurality of attached files held by said attached file holding unit;

Pollack, however, also in an analogous art, disclosed the attached-file specifying e-mail

including at least one identifier (file handler, refer to URL/file handler, 0056-0058) among the

unique identifiers generated by said identifier generation unit for each of the plurality of attached

files held by said attached file holding unit (refer to 0055-0060);

Hence, providing the feature suggested by Pollack, it would be desired for user to have a

generator that generate the unique identifier for the attachment files, for user to identify the file

that is desired to forward or attached. Therefore, at the time of the invention, it would have been

obvious to a person of ordinary skill in the art to combine AAPA, Hanna, and Pollack by

including the feature suggested in Pollack.

The suggestion/motivation would have been that by managing the stored file, it allows user to

quickly and easily manage the files on a network storage system on any device.


2. Referring to Claims 2, 6, 10, and 14, AAPA discloses wherein said attached file holding unit is

operable to, whenever receiving an e-mail that includes attached files, generate a list of the

attached files and pass the list of the attached files to said identifier generation unit (page 26);

and said identifier generation unit is operable to generate an identifier for each of the attached

files, respectively, in accordance with the list of the attached files passed by said attached file

holding unit (page 26).


3. Referring to Claims 3, 7, 11, 15, and 18, AAPA discloses wherein said mail terminal further

comprises: a file format registration unit operable to register one or more file formats of attached

files for each receiver's address that the receiver should adopt in said mail gateway (attachment is inherent comprises a type of file format, page 26);

wherein said mail gateway further comprises: a file format storage unit operable to store receivers' addresses and file formats that are registered by said file format registration unit (page 26);

and a file format conversion unit operable to convert a file format of each attached file for each receiver's address in accordance with the receivers' addresses and the file formats that are stored in the said format storage unit (page 26); and

wherein said construction unit is operable to construct the file attached e- mail by attaching each attached files converted by said file format conversion unit from and as a substitute for each attached file acquired by said attached file acquisition unit, respectively (substitute the file attachment with mail ID, page 26).

4. Referring to Claims 4, 8, 12, 16, and 19, AAPA discloses all the limitation in Claim 1, furthermore, AAPA discloses wherein said mail terminal further comprises: a sharing notification unit operable to notify said mail gateway that one or more attached files included in an e-mail addressed to the user of said mail terminal are to be shared with other users (send email to the destination, refer to page 26);

wherein said mail gateway further comprises:

an attached file sharing unit operable to, when receiving the notification that the one or more attached files are to be shared with the other users from said mail terminal share each of the attached files held by said attached tile holding unit with the other users (refer to page 26);

wherein said sharing notification unit includes:

a shared file notification unit operable to notify said mail gateway of one or more identifiers

(each attachment does has unique ids) selected by the user from the identifier list as substitutes

for the one or more attached files that are permitted to be shared (page 26);

and a sharer notification unit operable to notify said mail gateway of one or more sharers of each

of the attached files that are to be shared with the other users (page 26);

wherein said attached file sharing unit is operable to share attached files that correspond to the

identifiers notified from said shared file notification unit among attached files held by the-said

attached file holding unit with the sharers notified from said sharer notification unit (page 26):

wherein said list transmission unit is further operable to transmit a list of the shared identifiers to

the sharers of the attached files wherein said attached file acquisition unit further operable to

acquire attached files that correspond to the shared identifiers and wherein said list reception unit

further operable to receive a list of shared identifiers that have one to one correspondence to each

of the attached files that are shared by the user of said mail terminal as one member of the

sharers (page 26).

AAPA, nor Hanna expressly comprising an identifier generation unit operable to generate an

unique identifier for each attached files held by said attached file holding unit, respectively;

Pollack disclosed an identifier generation unit (producing calls) operable to generate an unique

identifier for each attached files held by said attached file holding unit, respectively (refer to

0013);

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to

combine AAPA, Hanna, and Pollack since the inventions are analogous.

The suggestion/motivation would have been that by managing the stored file, it allows user to quickly and easily manage the files on a network storage system on any device.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-20, 24, 28, 32, 36, 39, 43, 47, 50, 54, and 58 have been considered but are moot in view of the new ground(s) of rejection.
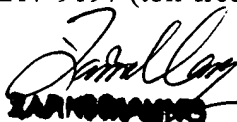
### *Conclusion*

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR . system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SUPERVISORY PATENT EXAMINER